

REMARKS

Claims 1-31 are pending. Claims 30 and 31 were submitted in the amendment filed 12 April 2007. In the latest Action, which the Examiner made Final, the Examiner deemed the new claims "withdrawn due to original presentation." No restriction requirement was made, nor would it have been proper given the substantial overlap of subject matter of claim 1 and claim 30. Reconsideration is requested.

Applicant is filing a Request for Continuing Examination with this amendment specifically to have claims 30 and 31 also be examined, along with new dependent claims 32-38. Claims 32-38 are copied from original claims 2, 3, 4, 6, 8, 9 and 16, but dependent from claim 30.

Claims 1-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic US Pat. No. 5,943,423 in view of Beecham US Pat. No. 5,876,926.

Fundamentally, the Examiner's piecemeal approach -- picking and choosing elements for the Muftic and Beecham references is flawed. A prima facie case of obviousness is not made for at least two reasons:

First, it evinces a hindsight approach to determining whether the claimed invention would have been obvious at the time the invention was made, based on an after the fact review of whether the Examiner can find elements in the references that answer one at a time to the elements in the claims. This is apparent from the fact that for many elements the Examiner acknowledges that Muftic does not teach or suggest such elements but then looks to see if such elements can be found in Beecham, without regard for context or whether the found elements can even fit together. This approach is improper under 35 USC 103 and the controlling case law.

Second, this approach disregards the overall architecture of the claimed subject matter, which is set forth in the claims, and is not found in either of the Muftic and Beecham references. As explained below, the claimed method and system operate in essentially a triangular fashion. As shown in each of FIGS. 1-4, the three corners or nodes of the triangle are the Merchant, the Identifier, and the User Access Device, with three communications channels connecting the three nodes. This triangular relationship is clearly set forth in the claims but is disregarded in the Examiner's piecemeal analysis. This analysis violates the mandate of 35 U.S.C. 103 to consider the invention as a whole. This architecture is readily distinguishable from both Muftic and Beecham, which operate in essentially linear fashion.

As mentioned in applicant's prior amendment, the claimed invention is an improvement over Pare and Hoffman, specifically applicable to using a consumer access device such as a cell phone, telephone, personal digital assistant or the like to carry out transactions with a merchant. A transaction can be initiated and agreed to between the consumer and merchant without input of a consumer biometric into a merchant device. The consumer's access device ID code is sent to the merchant, and also it is sent to the identicator. The merchant need never receive the consumer's biometric sample. When the biometric is input, it is input to the identicator without having to pass through the merchant's terminal. This is, in essence, a triangular transaction, as shown in all of the drawing figures.

Paraphrasing method claim 1, in a proposal step, a transaction is proposed between the merchant and the consumer via an access device. The access device communicates to the merchant an ID code associated with the access device. After the merchant and consumer have agreed on the transaction, the consumer and identicator establish communications with one another. Then the access device communicates the ID code to the electronic identicator. The identicator then compares a bid biometric sample from the consumer via the access device to a previously registered biometric sample to try to identify the consumer. Upon successful identification of the consumer, information is sent from the identicator to complete the transaction.

In Muftic, referring to FIG. 19, which is also on the front page of the Muftic patent, there are only two nodes -- the user and the server -- and one communication pathway back and forth between them. As the Examiner has noted at several places in the rejections, Muftic lacks any ability to input a user biometric and concomitantly lacks an identicator for comparing an input biometric of the user with a registered biometric. It follows, of course, that Muftic lacks any ability to establish communications between the identicator and either the user access device or a third party such as a merchant.

In Beecham, again the method and system are linear, as evidenced first by the flowcharts in FIGS. 3, 5, 6, 7, 8 and 9, and, second, by the fact that there is not a third party such as a merchant. Referring, for example, to FIGS. 7, 8 and 9, the user dials into a computer facility, inputs biometric data which the computer verifies, and the user then receives and communicates medical data. There are not three nodes, as in the claimed method and system, among which there are three distinct communications pathways.

Neither Muftic nor Beecham teach or suggest a method in which there are two access device identification steps of claim 1 -- one to the merchant, the second to the identicator. Nor do they teach or suggest a method in which the access device transmits the consumer's bid

biometric sample from the access device to the identicator after the transaction is agreed to.

Accordingly, claim 1 is patentable over Muftic and Beecham. Dependant claims 2-19 are likewise allowable. The dependent claims are further allowable in their own right based on the differences therein, such as the use of the access device ID code to associate the biometric identification accomplished in the consumer identification step with the transaction information in claim 2, or to associate the consumer information with the transaction in claim 3.

New method claim 30, which is patterned after claim 1 but directed to the steps post-registration, is similarly patentable. Dependents claim 31-38 are likewise patentable.

System claim 20 is likewise patentable over Muftic and Beecham. Neither those patents in general, nor the portions cited by the Examiner describe a system with three communications means, as recited in amended claim 20. Nor do they describe a system in which, in operation, an access device sends its identification code to the merchant and to the identicator and further sends the biometric sample to the identicator rather than to the merchant. Therefore, claim 20 is allowable, along with dependent claims 21-29.

Claim 30 is patentable over Muftic and Beecham for the reasons discussed above for claim 1. Dependent claims 31-38 are likewise allowable.

In view of the foregoing amendments and remarks, the application should be in condition for allowance.

If any questions remain, please call the undersigned.

Respectfully submitted,

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